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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,172	01/16/2002	Satoshi Inami	2002-0022A	2339
513	7590	05/31/2006	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			RIMELL, SAMUEL G	
2033 K STREET N. W.				
SUITE 800			ART UNIT	
WASHINGTON, DC 20006-1021			PAPER NUMBER	
			2164	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,172	INAMI ET AL.	
	Examiner	Art Unit	
	Sam Rimell	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The amendment filed March 3, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment in paragraph 0017 of the original specification. This amendment has not been approved for entry and raises the issue of new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 15: The second to last paragraph of claim 15 has been amended to recite a transmission data generating unit for determining among generated data, transmission data transmitted to the server. This paragraph further states that this determination is “..based on said transmission information specifying data..”

While the original disclosure does refer to a “transmission data generating unit” and does state that the transmission data generating performs determinations of transmission data (paragraph 0070 of original specification), it does not state how the determination is made. In

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particular, it does not state that the determination is “based on transmission information specifying data.” The only place where such a statement is made is in applicant’s amended version of the specification, not in the original specification, objected to above. Accordingly, the second to last paragraph of claim 15 contains new matter

Claims 16-20: Depend on claim 15.

Claim 21: Claim 21 has been amended to refer to “storing the data generated due to execution of the application” and “determining, from amongst the stored generated data, the transmission data to be transmitted to the server based on said transmission information specifying data;”

The original disclosure makes its closest reference to this concept at page 26, last paragraph, where it states:

“The transmission data generating unit then determines the transmission data amongst the generated data (step S82).”

The original disclosure further states (page 19, paragraph 0051):

“The application executing unit 42 is realized by the CPU 11 and RAM 12 that execute the application 131. Here, data generated by the application executing unit is called generated data.”

The original disclosure does not state that determination is made from amongst the stored generated data, where the data is derived from the execution of the application. Instead it states that the determination is made from amongst data generated by the application executing unit, which is not the data generated by the application itself.

Accordingly, the determining step quoted from claim 21 above is new matter, as it describes features that were not originally disclosed.

Claims 22-26: Depend on claim 21.

Claim 27: Same rationale as set forth for claim 15.

Claims 28-30: Depend on claim 27.

Claim 31: Same rationale as for claim 21.

Claims 32-34: Depend on claim 31.

Remarks

Applicant's arguments are directed to claims 15 and 27, which include an amendment referring to a transmission data generating unit. The amendment presented in claims 15 and 27 constitute new matter, since the original disclosure did not state that the transmission data generating unit makes a determination based on transmission information specifying data. The only support found for this amendment rests in applicant's amendment to the specification, which itself contains new matter.

Neither the amendment to the specification at paragraph 0017 or the amendments to claims 15 and 27 are found to be original matter, and accordingly are indicated as new matter.

No specific arguments or amendments are presented for independent claims 21 or 31, accordingly, the rejection of these claims are sustained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



SAM RIMELL
PRIMARY EXAMINER